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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,184	06/20/2005	Declan P. Kelly	NL021455	1205
24737 7590 01/18/2007 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			EXAMINER AMINZAY, SHAIMA Q	
			ART UNIT	PAPER NUMBER
			2618	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/540,184

Applicant(s)

KELLY ET AL.

Examiner

Shaima Q. Aminzay

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1-17 are objected under 37 CFR 1.75(c) as being improper, the reference designators are listed within the claims limitations, claim 13 is dependent of "computer-usable medium of claim 10", however, claim 10 is not an independent claim with "computer-usable medium" limitations, therefore, claim 13 should be dependent of -- computer-usable medium of claim 12 --. For the sake of examining the claims on the merit, Examiner assumes the above corrections. Applicant's correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-12, 14-16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato (Kato, U.S. Patent 6,453,233).

Regarding claim 1, Kato discloses a method for receiving updated information using a portable disk-based information device (*see for example, Figures 1-7, column 1, lines 15-65, column 4, lines 57-60, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the portable disk type information device (electronic device, i.e. terminal units) receives the latest information*), comprising: requesting update information from a data provider (*see for example, Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the portable disk type information device (electronic device, i.e. terminal unit) requests updated/latest information from the provider*); receiving the update information from the data provider (*see for example, Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the portable electronic device receives the latest information from the provider*); comparing the update information with information provided on the disk (*see for example, Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the received updated information is being compared and verified with respect to disk stored information*); and delivering updated information to a user in response to a user request (*see for example, Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, the received updated information is being transmitted to the portable electronic device (user) per user*

request), reporting new information and replacing outdated information provided on the disk with information received from the data provider (see for example, Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37, the new and updated information is being provided on the storage medium (disk, CD, DVD, etc.) with provider data).

Regarding claim 12, Kato discloses a computer-usable medium for receiving updated information using a portable disk-based information device (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 57-60, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the computerized medium receiving updated information using the portable disk type information device (electronic device, i.e. terminal units)), comprising: computer program code for requesting update information from a data provider (see for example, *Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the software program for requesting updated/latest information from the provider); computer program code for receiving the update information from the data provider (see for example, *Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the software program for receiving the latest information from the provider); computer program code for comparing the update information with information provided on the disk (see for example, *Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67,****

column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the received updated information is being compared and verified with respect to disk stored information); and computer program code for delivering updated information to a user in response to a user request (see for example, Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, the received updated information is being transmitted to the portable electronic device (user) per user request), reporting new information and replacing outdated information provided on the disk with information received from the data provider (see for example, Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37, the new and updated information is being provided on the storage medium (disk, CD, DVD, etc.) with provider data).

Regarding claim 16, Kato discloses a system for receiving updated information using a portable disk-based information device (see for example, Figures 1-7, column 1, lines 15-65, column 4, lines 57-60, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the system for portable disk type information device (electronic device, i.e. terminal units) receives the latest information), comprising: means for requesting update information from a data provider (see for example, Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the portable disk type information device (electronic device, i.e. terminal unit)

requests updated/latest information from the provider); means for receiving the update information from the data provider (see for example, *Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the portable electronic device receives the latest information from the provider*); means for comparing the update information with information provided on the disk (see for example, *Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the received updated information is being compared and verified with respect to disk stored information*); and means for delivering updated information to a user in response to a user request (see for example, *Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, the received updated information is being transmitted to the portable electronic device (user) per user request*), reporting new information and replacing outdated information provided on the disk with information received from the data provider (see for example, *Figures 1-3, column 4, lines 6-64, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37, the new and updated information is being provided on the storage medium (disk, CD, DVD, etc.) with provider data*).

Regarding claim 18, Kato discloses a method for receiving updated information using a disk-based information device (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 57-60, column 5, lines 10-41, lines 66-67,*

column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the portable disk type information device (electronic device, i.e. terminal units) receives the latest information), comprising: broadcasting update information from a data provider (see for example, Figures 1-3, column 1, lines 15-24, lines 56-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, using the radio-communication inks (broadcasting) update information from the provider); receiving the update information from the data provider (see for example, Figures 1-3, column 1, lines 15-24, lines 56-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the portable electronic device receives the latest information from the provider); comparing the update information with information provided on the disk (see for example, Figures 1-3, column 1, lines 15-24, lines 56-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37, the received updated information is being compared and verified with respect to disk stored information); and delivering updated information to a user in response to a user request (see for example, Figures 1-3, column 1, lines 15-24, lines 56-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, the received updated information is being transmitted to the portable electronic device (user) per user request), reporting new information and replacing outdated information provided on the disk with information received from the data provider (see for example, Figures 1-3, column 1, lines 15-24, lines 56-65, column 4, lines

6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37, the new and updated information is being provided on the storage medium (disk, CD, DVD, etc.) with provider data).

Regarding claim 3, Kato teaches all the limitations of claim 1, and further, Kato teaches wherein the disk-based information device is one of a navigation device, a city guide, a hotel guide, a transportation schedule, or a business directory (see for example, *Figures 1-3, column 1, lines 15-24, lines 56-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*).

Regarding claim 4, Kato teaches all the limitations of claim 1, and further, Kato teaches wherein the disk-based information device is operably connected to a portable networking device (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 57-60, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 52-55, column 10, lines 34-37*).

Regarding claim 5, Kato teaches all the limitations of claim 4, and further, Kato teaches wherein the portable networking device 110 is one of a personal data assistant (PDA) or a cellular telephone (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*).

Regarding claim 6, Kato teaches all the limitations of claim 1, and further, Kato teaches wherein the data provider 150 is accessed through a wireless communication network (*see for example, Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*).

Regarding claim 7, Kato teaches all the limitations of claim 4, and further, Kato teaches wherein the wireless communication network is one of a mobile telephone network, a local-area network, or a satellite network (*see for example, Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*).

Regarding claim 8, Kato teaches all the limitations of claim 1, and further, Kato teaches wherein the disk-based information device includes a read-only small form factor optical disk (*see for example, Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-41, lines 66-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*).

Regarding claim 9, Kato teaches all the limitations of claim 1, and further, Kato teaches wherein some or all update information from the data provider is stored using one or more storage means selected from a group consisting of memory

caching (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*), disk caching, non-volatile random access memory (NVRAM), magnetoresistive random access memory (MRAM), and a mixed-function disk (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*).

Regarding claims 10 and 14, Kato teaches all the limitations of claim 1, 12, and further, Kato teaches wherein requesting update information from a data provider comprises sending one or more items selected from a group consisting of the user's search criteria (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*), the geophysical location of the disk-based information device (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*), identifiers for the user of the disk-based information device (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*), identifiers for the application being used, and identifiers for the disk being used (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*).

Regarding claims 11 and 15, Kato teaches all the limitations of claims 10, 14, and further, Kato teaches wherein information sent to the data provider is used to minimize the amount of update information transferred by the data provider (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-67, column 6, lines 1-6, lines 18-55, column 10, lines 34-37*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action.

(a) Patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (Kato, U.S. Patent 6,453,233) in view of Walsh (Walsh et al., U.S. Patent 6,965,770).

Regarding claims 2, 13, and 17, Kato teaches all the limitations of claims 1, 12, 16, and further, Kato teaches first agreeing to accept [*charges associated with*] receiving update information from a data provider (see for example, *Figures 1-7, column 1, lines 15-65, column 4, lines 6-65, column 5, lines 10-67, column 6,*

lines 1-6, lines 18-55, column 10, lines 34-37), however, Kato does not specifically teaches to accept charges.

In related art dealing with portable computer based (disk-based) device in communication system, Walsh teaches accepting the cost (*see for example, Figures 1-20, column 1, lines 6-53, column 6, lines 28-67, column 10, lines 6-32*).

It would have been obvious to one of ordinary skill in the art at the time invention was made to include Walsh's accepting the cost with Kato's to provide a communication system with a portable device collecting updated information "regarding the user's request(s), and allowing the user to make more requests, or end the request process" including fees dynamically delivered service (Walsh, *see for example, column 2, lines 5-14, column 6, lines 42-45*).

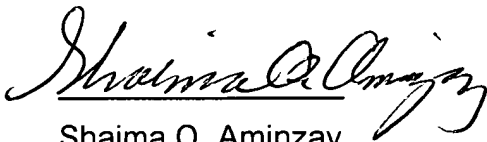
Conclusion

The prior art made of record considered pertinent to applicant's disclosure, see PTO-892 form.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaima Q. Aminzay whose telephone number is 571-272-7874. The examiner can normally be reached on 7:00 AM -4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mathew D. Anderson can be reached on 571-272-4177. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

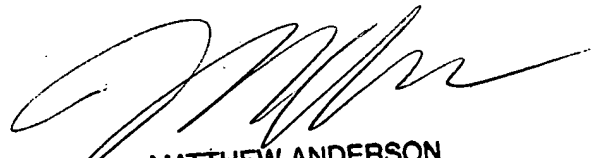
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shaima Q. Aminzay

(Examiner)

January 10, 2007



MATTHEW ANDERSON
SUPERVISORY PATENT EXAMINER